

## REMARKS

This submission is in further response to the FINAL Office Action and the Advisory Action mailed April 16, 2007.

### **New Claim 22**

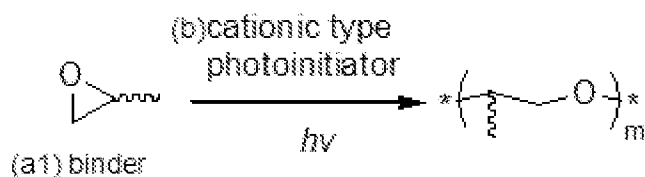
New claim 22 is added to define a particularly embodiment of the present invention. The features of claim 22 are fully supported by the original specification and claims. Therefore, no new matter is added to the application by this claim, nor are any 112, first paragraph issues implicated, as the features of this claim also appear in various of the original claims.

### **Response to Rejections Under 35 U.S.C. 103 (a)**

The Final Office Action and Advisory Action reject claims 1, 2, 6-11, and 14-19 under 35 U.S.C. 103 (a) as allegedly unpatentable over Nojima (US 6,399,277) in view of Schulta (US 6,306,555). Applicant respectfully requests reconsideration for at least the reasons that follow.

The presently claimed embodiments define a composition comprising photoacid cationic generator which polymerizes monomers or resins when exposing a UV-ray. **In contrast, the setting adhesion-imparting agent used in Nojima is a thermal-setting cationic initiator which polymerizes monomers or resins when heating, since Nojima uses setting adhesion-imparting agent to bonding the COOH group of resin with the expoy.** Nojima does not teach or suggest the use of a photo-setting cationic generator.

Schulta, however, allegedly teaches the use of a photo-setting cationic generator.



The Examiner is reminded that to establish a *prima facie* case of obviousness, three criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teaching. Second, **there must be a reasonable expectation of success**, according to MPEP 2142. The applicant submits that the Examiner has failed to satisfy these criteria in asserting that the rejected claim is obvious in view of Nojima combined with the Schultz.

Nojima discloses a photopolymerizable **thermosetting** resin composition for forming a solid resist used in PCB (printed circuit board), and in general the solid resist **would not apt to be removed after forming**. However, neither Schultz nor this invention relate to a photopolymerizable **thermosetting** resin composition. Therefore, Schultz's patent does not teach methods, which solve the same problems as the Nojima. Instead, Schultz teaches using a photo-setting acid generator, but Nojima teaches using a thermal-setting acid generator. Thus, there is no **suggestion or motivation**, either in the references themselves or in knowledge generally available to one of ordinary skill in the art, to modify the references or combine reference teachings.

The Examiner is also reminded that “the teaching or suggestion to make the claimed combination must both be found in the prior art, and not in applicant’s disclosure.”

MPEP 2143 *citing In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Accordingly, it appears that the motivation to combine Nojima et al. with Schultz’s patent was derived from the Applicant’s disclosure, and not by the prior art.

As well, the Examiner is reminded that “The mere fact that it is possible to find two isolated disclosures that might be combined in such a way to produce a new compound does not necessarily render such production obvious unless the art also contain something to suggest the desirability of the proposed combination. In the absence of such a reference suggestion, there is inadequate support for the position that the required modification would prima facie have been obvious.” *In re Grabiak*, 226 U.S.P.Q. 870 (Fed. Cir. 1985).

Further, MPEP section 2141 states:

Office policy has consistently been to follow *Graham v. John Deere Co.* in the consideration and determination of obviousness under 35 U.S.C. 103. As quoted above, the four factual inquiries enunciated therein as a background for determining obviousness are briefly as follows:

- (A) Determining of the scope and contents of the prior art;
- (B) Ascertaining the differences between the prior art and the claims in issue;
- (C) Resolving the level of ordinary skill in the pertinent art; and
- (D) Evaluating evidence of secondary considerations.

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#### BASIC CONSIDERATIONS WHICH APPLY TO OBVIOUSNESS REJECTIONS

When applying 35 U.S.C. 103, the following tenets of patent law must be adhered to:

- (A) The claimed invention must be considered as a whole;
- (B) The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination;

- (C) The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention and
- (D) Reasonable expectation of success is the standard with which obviousness is determined.

Hodosh v. Block Drug Co., Inc., 786 F.2d 1136, 1143 n.5, 229 USPQ 182, 187 n.5 (Fed. Cir. 1986).

The foregoing approach to obviousness determinations was recently confirmed by the United States Supreme Court decision in *KSR INTERNATIONAL CO. V. TELEFLEX INC. ET AL.* 550 U.S. \_\_\_\_ (2007)(No. 04-1350, slip opinion, p. 2), where the Court stated:

In *Graham v. John Deere Co. of Kansas City*, 383 U. S. 1 (1966), the Court set out a framework for applying the statutory language of §103, language itself based on the logic of the earlier decision in *Hotchkiss v. Greenwood*, 11 How. 248 (1851), and its progeny. See 383 U. S., at 15–17. The analysis is objective:

“Under §103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, longfelt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.” *Id.*, at 17–18.

Simply stated, the Office Action has failed to at least (1) ascertain the differences between and prior art and the claims at issue; and (2) resolve the level of ordinary skill in the art. Furthermore, the alleged rationale for combining the two references (i.e., because it “was old and well known in the computer art to get the advantage of the ability of accessing data in random order by implementing the buffer in RAM”) embodies clear and improper hindsight rationale. For at least these additional reasons, Applicant submits that the rejections of claim 1 is allowable over Nojima in view of Schulta.

## **CONCLUSIONS**

Applicant submits that all rejections have been overcome by the above remarks and respectfully requests allowance of all pending claims.

In addition, any other statements in the Office Action that are not explicitly addressed herein are not intended to be admitted. In addition, any and all findings of inherency are traversed as not having been shown to be necessarily present. Furthermore, any and all findings of well-known art and official notice, or statements interpreted similarly, should not be considered well known since the Office Action does not include specific factual findings predicated on sound technical and scientific reasoning to support such conclusions.

Should the Examiner believe that a teleconference would be helpful to expedite the examination of this application, the Examiner is invited to contact the undersigned.

A credit card authorization is provided herewith to cover the fees associated with the accompanying extension of time and RCE application. No additional fee is believed to be due in connection with this amendment and response. If, however, any additional fee is deemed to be payable, you are hereby authorized to charge any such fee to Deposit Account No. 20-0778.

Respectfully submitted,

/Daniel R. McClure/

By:

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